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EXAMINER

LUONG, VINH

ART UNIT PAPER NUMBER

3682

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/657,954

Applicant(s)

CRISSY, MICHAEL

Examiner

Vinh T. Luong

Art Unit

3682

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-12 and 14-18 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-8,10-12 and 14-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

1. The Amendment filed on July 12, 2006 has been entered.
2. The Amendment filed on July 12, 2006 is objected to because, *inter alia*, the amendments to the claims are not in compliance with 37 CFR 1.121(c). For example, 37 CFR 1.121(c)(2) requires: “[t]he text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters.” In the instant case, in claim 1, line 4, Applicant deleted the characters “hub” after “said polymer” (see claim 1 in the Amendment filed on April 3, 2006), however, the characters “hub” were not shown by strike-through. Similar problem is seen in line 7 of claim 10.
3. Claims 9 and 18 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on April 3, 2006.
4. The drawings were received on July 12, 2006. These drawings are unacceptable by the Examiner because the drawings are not in compliance with 37 CFR 1.84. For example, in the specification, the amended paragraph beginning at page 9, line 21, describes the jaw members 62, however, the drawings do not show the referential character “62.” See 37 CFR 1.84(p)(5).
5. The drawings are objected to because the drawings are not in compliance with 37 CFR 1.84. For example, in the specification, the amended paragraph beginning at page 9, line 21, describes the jaw members 62, however, the drawings do not show the referential character “62.” See 37 CFR 1.84(p)(5).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement-drawing

Art Unit: 3682

sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

6. The disclosure is objected to because of the following informalities: the specification is inconsistent with the drawings or *vice versa*. For example, in the specification, the amended paragraph beginning at page 9, line 21, describes the jaw members 62, however, the drawings do not show the referential character “62.” See 37 CFR 1.84(p)(5) and 1.121(e). Appropriate correction is required.

7. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter, e.g., “a plurality of portions” in claims 1 and 10. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction is required.

8. Claims 1-3, 5-8, 10-12, and 14-17 are objected to because of the following informalities, such as, e.g., the term “force” in claims 1 and 10 should have been changed to “a force.” Appropriate correction is required.

Art Unit: 3682

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

10. Claims 1-3, 5-8, 10-12, and 14-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear whether the term “a plurality of portions” in amended claims 1 and 10 refers to the flange 42 or the lips 44 or both. See paragraph [0020] of the specification. Note that the original claims 4 and 13 call for “a portion” (singular, emphasis). Applicant is respectfully urged to identify each claimed element with reference to the drawings.

11. Claims 1, 5-7, 10, and 14-16, as best understood, are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4, 7, 9-12, and 14 of Pat.’113. Although the conflicting claims are not identical, they are not patentably distinct from each other because Applicant apparently uses different terminologies in order to claim substantially the same invention. *In re Griswold*, 150 USPQ 804 (CCPA 1996).

Regarding claims 1 and 10 of this application, see, *e.g.*, the comparison between claims 1 and 10 of this application and claims 1, 7, 9, and 14 of Pat.’113 below.

| <u>Common</u> | <u>Appl.’954</u> | <u>Pat.’113</u> |
|-----------------|--------------------|-----------------|
| | coupling structure | damper |
| | polymer hub | polymer body |
| | longitudinal axis | rotational axis |
| service ports | | |
| metallic insert | (claims 1 and 10) | (claims 7 & 14) |

tubular sleeve

circumference of the insert

annular insert flange
including a plurality of
portions (44)plurality of support flanges
(50)

It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the coupling structure/damper claimed in claims 1 and 10 of this application as taught or suggested by claims 1, 7, 9, and 14 of Pat.'113 or *vice versa*.

Regarding claims 5 and 14 of this application, the sleeve/circumference of the insert claimed in Pat.'113 inherently provides a press fit with the shaft 11. Note that a “whereby” or “wherein” clause that merely states the inherent result of the limitations set forth in the claim adds nothing to the patentability or substance of the claim. *Texas Instrument Inc. v. International Trade Commission*, 26 USPQ2d 1018 (Fed. Cir. 1993); *Griffin v. Bertina*, 62 USPQ2d 1431 (Fed. Cir. 2002); and *Amazon.com Inc. v. Barnesandnoble.com Inc.*, 57 USPQ2d 1747 (Fed. Cir. 2001).

Regarding claims 6, 7, 15, and 16 of this application, see claims 2-4 and 10-12 of Pat.'113.

12. Claims 2, 3, 8, 11, 12, and 17 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

13. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Art Unit: 3682

14. Applicant's arguments filed July 12, 2006 have been fully considered but they are not persuasive.

Drawing Objection

The replacement drawings have been disapproved for the reasons set forth above.

Disclosure Objection

The amended specification is inconsistent with the drawings. Therefore, the objection is respectfully maintained.

Claim Objection

The objection to the claim is maintained for the reasons set forth above.

Specification Objection

Paragraph [0020] of the specification describes “a radially inward projecting portion or flange 42” (singular, emphasis). The amended claims now call for “a plurality of portions” (plural, emphasis). MPEP 608.01(o) states:

New claims and amendments to the claims already in the application should be scrutinized not only for new matter but also for new terminology. *While an applicant is not limited to the nomenclature used in the application as filed, he or she should make appropriate amendment of the specification whenever this nomenclature is departed from by amendment of the claims so as to have clear support or antecedent basis in the specification for the new terms appearing in the claims.* This is necessary in order to insure certainty in construing the claims in the light of the specification, *Ex parte Kotler*, 1901 C.D. 62, 95 O.G. 2684 (Comm’r Pat. 1901). See 37 CFR 1.75, MPEP § 608.01(i) and § 1302.01. Note that examiners should ensure that the terms and phrases used in claims presented late in prosecution of the application (including claims amended via an examiner’s amendment) find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description, see 37 CFR 1.75(d)(1). (Emphasis added).

Art Unit: 3682

In this case, the specification provides antecedent basis for the term “a plurality of lips,” but not “a plurality of portions.” Therefore, Amended claims 1 and 10 necessitated new objection above.

35 USC 112, 2nd Paragraph

The amended claims necessitated new grounds of rejection under 35 USC 112 above.

Art Rejection

The previous art rejections are withdrawn in view of Applicant’s amendment.

Obviousness-Type Double Patenting

Applicant contended that Applicant has amended independent claims 1 and 10 to add the subject matter of the original dependent claims 4 and 13. However, the original claims 4 and 13 called for “a portion of said insert flange” (singular, emphasis). By claiming “a plurality of portion,” claims 1 and 10 do not incorporate the subject matter of claims 4 and 13. Neither claim 4 nor claim 13 was subjected to obviousness-type double patenting because claim 4 or 13 requires “a portion of said insert flange” (singular, emphasis). Meanwhile, the recitation “a plurality of portions” in amended claims 1 and 10 are corresponding to “a plurality of support flanges” in claims 1 and 9 of Pat.’113. See *In re Griswold, supra*. Therefore, the amended claims necessitated new grounds of rejection under obviousness-type double patenting above.

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

Art Unit: 3682

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 571-272-7109. The examiner can normally be reached on Monday - Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

September 18, 2006



Vinh T. Luong
Primary Examiner